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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,723	06/27/2003	Nelson F. Kidd	42P15966	6494
8791	7590	01/03/2007	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN			FLEURANTIN, JEAN B	
12400 WILSHIRE BOULEVARD			ART UNIT	PAPER NUMBER
SEVENTH FLOOR			2162	
LOS ANGELES, CA 90025-1030				
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/03/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/607,723	KIDD ET AL.	
	Examiner JEAN B. FLEURANTIN	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments submitted on 10/19/06.

The following is the current status of claims:

Claims 1-18 remain pending for examination.

Response to Applicant' Remarks

Applicant's arguments filed 10/19/06 have been fully considered but they are not persuasive for the following reasons, see section I (rejection maintained and repeated below) and section II (response to argument).

Claim Rejections - 35 USC § 101

- I. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106:

Products may be either machines, manufactures, or compositions of matter.

A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

As per claim 7,

Claim 7, in view of the above cited MPEP section is not statutory, because "to select entries to store based at least in part upon both a spacing between the entries in the index file" does not produce any useful and tangible result.

As per claim 13,

Claim 7, in view of the above cited MPEP section is not statutory, because "the index agent to select entries to store based at least in part upon both a spacing between the entries in the index file" does not produce any useful and tangible result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-7, 9, 12-13, 15 and 18 as best understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,697,801 issued to Eldredge et al., ("Eldredge") in view of U.S. Pat. No. 5,765,164 issued to Prasad et el., ("Prasad").

As per claim 1, Eldredge discloses "a method comprising parsing a received index file" (i.e., parsing and indexing text; see col. 3, line 16-17) "to extract one or more entries" (i.e., extracting entity; see col. 10, lines 5-7); and

"selecting at least a subset of the extracted entries" (i.e., retrieving (selecting) a first or lower level text entities; see col. 3, lines 31-35) "to store based at least in part upon both a spacing between the entries in the index file" (i.e., spacing between entities; col. 9, lines 1-6); and

"storing the selected entries" (i.e., stored entries; see col. 10, lines 57-58).

Eldredge fails to explicitly disclose an amount of memory available for allocation. However, Prasad discloses an amount of memory available for allocation (see Prasad col. 8, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Eldredge by an amount of memory available for allocation as disclosed by Prasad (see Prasad col. 8, lines 58-59 and Fig. 5). Such a modification would allow the method of Eldredge to provide a

method for temporal indexing for storing and retrieval of multiple audio and video (see Prasad col. 3, lines 62-65), therefore, improving the accuracy and the reliability of the method, apparatus and system for efficient file index.

As per claims 4, 9 and 15, in addition to claim 1, Eldredge further discloses parsing the play list to extract Universal Resource Indicators (URI's) (In light the specification at paragraph [0015], the purpose of using Universal Resource Indicators (URI's) is for identifying network locations where electronic music files (index files) are stored. The method for storing index files is disclosed by Eldredge col. 8, lines 55-66, specifically lines 63-66).

As per claim 6, in addition to claim 1, Eldredge further discloses "selecting at least a subset of the extracted entries" (i.e., retrieving (selecting) a first or lower level text entities; see col. 3, lines 31-35) "to store without a priori knowledge as to a number of entries within the index file" (In light the specification at paragraph [0037], lines 2-8, the purpose of storing a number of entries is based on a calculated spacing between index entries. The method for spacing between entities is disclosed by Eldredge col. 9, lines 1-6).

As per claim 7, Eldredge discloses "an electronic appliance" (In light the specification at paragraph [0014], lines 1-2, an electronic appliance represents any type of electronic appliance that stores index file as disclosed by Eldredge see col. 8, lines 55-57), comprising;

"a network interface to receive an index file" (i.e., interfacing to receive (store) index file; see col. 9, lines 24-29 and Fig. 1); and

"an index engine coupled with the network interface" (i.e., interfacing to receive (store) index file; see col. 9, lines 24-29 and Fig. 2);

"the index engine to parse the index file for entries" (i.e., parsing and indexing text (file); see col. 3, line 16-17) and "to select entries to store" (i.e., storing index values with the entities; see col. 10, lines

54-55) "based at least in part upon both the spacing between the entries in the index file" (i.e., spacing between entities; col. 9, lines 1-6).

Eldredge fails to explicitly disclose an amount of memory available for allocation. However, Prasad discloses an amount of memory available for allocation (see Prasad col. 8, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Eldredge by an amount of memory available for allocation as disclosed by Prasad (see Prasad col. 3, lines 28-37 and col. 8, lines 58-59 and Fig. 5). Such a modification would allow the system of Eldredge to provide a temporal indexing for storing and retrieval of multiple audio and video (see Prasad col. 3, lines 62-65), thereby improving the accuracy and the reliability of the method, apparatus and system for efficient file index.

As per claim 12, in addition to claim 7, Eldredge further discloses "selecting at least a subset of the extracted entries" (i.e., retrieving (selecting) a first or lower level text entities; see col. 3, lines 31-35) "to store without a priori knowledge as to a number of entries within the index file" (In light the specification at paragraph [0037], lines 2-8, the purpose of storing a number of entries is based on a calculated spacing between index entries. The method for spacing between entities is disclosed by Eldredge col. 9, lines 1-6).

As per claim 13, Eldredge discloses "a storage medium" (i.e., warehousing (storage medium); see col. 3, line 44) comprising "content which, when executed by an accessing machine" (i.e., executing instructions; see col. 3, lines 44-45), "cause the machine to implement an index agent in the accessing machine" (i.e., receiving index values; see col. 8, lines 30-33), "the index agent to parse the index file to extract entries" (i.e., parsing and indexing text; see col. 3, line 16-17), "the index agent to select entries" (i.e., retrieving (selecting) a first or lower level text entities; see col. 3, lines 31-35) "to store based at least in part upon both a spacing between the entries in the index file" (i.e., spacing between entities; col. 9, lines 1-6), and "the index agent to store the selected entries into the memory" (i.e., index values storing with the entities; see col. 10, lines 54-55).

Eldredge fails to explicitly disclose the index agent to receive an index file from a remote location in response to an event associated with a request and an allocation memory. However, Prasad discloses the index agent to receive an index file from a remote location in response to an event associated with a request (see Prasad col. 3, lines 28-37) and an allocation of memory (see Prasad col. 8, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Eldredge by the index agent to receive an index file from a remote location in response to an event associated with a request and an allocation memory as disclosed by Prasad (see Prasad col. 3, lines 28-37 and col. 8, lines 58-59 and Fig. 5). Such a modification would allow the method of Eldredge to provide a method and apparatus for temporal indexing for storing and retrieval of multiple audio and video (see Prasad col. 3, lines 62-65), thereby improving the accuracy and the reliability of the method, apparatus and system for efficient file index.

As per claim 18, in addition to claim 13, Eldredge further discloses "causes the accessing to select entries" (i.e., retrieving (selecting) a first or lower level text entities; see col. 3, lines 31-35) "to store without a priori knowledge as to a number of entries within the index file" (In light the specification at paragraph [0037], lines 2-8, the purposed of storing a number of entries is based on a calculated spacing between index entries. The method for spacing between entities is disclosed by Eldredge col. 9, lines 1-6).

Claims 2-3, 5, 8, 10-11, 14 and 16-17 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,697,801 issued to Eldredge et al., ("Eldredge") in view of U.S. Pat. No. 5,765,164 issued to Prasad et el., ("Prasad") as applied to claims 1, 4, 6-7, 9, 12-13, 15 and 18 above, and further in view of Brent A. Miller et al., "Home Networking with Universal Plug and Play", pages 104-109, ("Miller").

As per claims 2, 8 and 14, in addition to claim 1, Eldredge fails to explicitly disclose parsing a play list received through Universal Plug and Play (UPnP) networked communication. However, Miller discloses parsing a play list received through Universal Plug and Play (UPnP) networked communication (see Miller page 104, col. 1, paragraph introduction – 2 and 3). It would have been obvious to a person of

ordinary skill in the art at the time the invention was made to modify the method of Eldredge by parsing a play list received through Universal Plug and Play (UPnP) networked communication as disclosed by Miller (see Miller page 106, col. 1, paragraph introduction – 2 and 3). Such a modification would allow the method of Eldredge to provide a mechanism for universal control (see Miller page 108, col. 2, last paragraph, lines 1-2), thereby improving the accuracy and the reliability of the method, apparatus and system for efficient file index.

As per claim 3, Eldredge further discloses “sorting the stored entries” (i.e., sorting the index; see col. 9, lines 26-28).

As per claims 5, 11 and 17 in addition to claim 4, Eldredge fails to explicitly issuing a Hyper Text Transfer Protocol (HTTP)-RANGE command to retrieve an URI not stored in the memory. However, Miller discloses issuing a Hyper Text Transfer Protocol (HTTP)-RANGE command to retrieve an URI not stored in the memory (see Miller page 104, col. 2, paragraphs 1-2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Eldredge by discloses issuing a Hyper Text Transfer Protocol (HTTP)-RANGE command to retrieve an URI not stored in the memory as disclosed by Miller (see Miller page 106, col. 1, paragraph description to col. 2, last paragraph and Figs. 1 and 2). Such a modification would allow the method of Eldredge to provide a mechanism for universal control (see Miller page 108, col. 2, last paragraph, lines 1-2), thereby improving the accuracy and the reliability of the method, apparatus and system for efficient file index.

As per claim 10, Eldredge further discloses “sorting the stored entries” (i.e., sorting the index lexically (file); see col. 9, lines 26-28).

As per claim 16, Eldredge further discloses "sorting the stored entries" (i.e., sorting the index; see col. 9, lines 26-28).

II. Applicant stated, page 8, last paragraph, that the use of the word "should" and the phrase "when set forth" indicates that inclusion of a "Summary of the Invention" section is optional rather than mandatory. As a result, it is believed there is no legal basis upon which to require a patent applicant to provide a "Summary of the Invention" section in a patent application or to require an applicant to amend the patent application to include such a summary. Therefore, the objection and any requirement related thereto should be withdrawn. Thus, the arguments have been fully considered and are persuasive. The objection of the specification has been withdrawn.

The amendment of Claim 1, has overcome the 35 U.S.C. 101 rejection(s). Thus, the rejection(s) has (have) been withdrawn.

Further, Applicant stated, page 9, last paragraph, that "Applicant has amended claims 1 and 7 and traverses the rejection of claim 13. Claims 1, 7 and 13 include storing selected entries which is a tangible result, and not a manipulation of an abstract idea or a performance of a purely mathematical algorithm. Accordingly, Applicant respectfully requests that the § 101 rejection be withdrawn."

Wherein, claim 7 recites:

An electronic appliance, comprising:

a network interface to receive an index file; and

an index engine coupled with the network interface, the index engine to parse the index file for entries and to select entries to store based at least in part upon both the spacing between the entries in the index file and an amount of memory available for allocation.

Claim 13 recites:

A storage medium comprising content which, when executed by an accessing machine, causes the machine to implement an index agent in the accessing machine, the index agent to receive an index file from a remote location in response to an event associated with a request, the index agent to parse the

index file to extract entries, the index agent to select entries to store based at least in part upon both the spacing between the entries in the index file and an allocation of memory, and the index agent to store the selected entries into the memory.

The Examiner having difficulty to locate the amendment to claims 7 and 13. Thus, the 35 U.S.C 101 rejection(s) maintains (maintain).

In response to applicant's arguments, page 9, paragraphs 2 and 3, have been fully considered and are not persuasive, thus the 35 U.S.C. 112 rejection(s) has (have) been withdrawn.

On page 10, paragraphs 2 and 3, Applicant stated that claim 1 recites in pertinent part, "selecting at least a subset of the extracted entries to store based at least in part upon both a spacing between the entries in the index file and an amount of memory available for allocation." Eldredge, however, neither discloses nor suggests this element of claim 1. In fact, Eldredge teaches away from this element, by teaching classifying of every entry as either first level text entries or lower level text entries, as opposed to storing only select entries. See Eldredge, Abstract. Applicant notes that Prasad is not cited as curing, and does not cure, the above deficiency of Eldredge as applied to, e.g., rejected claim 1. Thus, without the need to further characterize Prasad, and without adopting the characterization found in the Action, Applicant respectfully asserts that rejected claim 1 is, indeed, patentable over the Eldredge and Prasad combination of references."

It is noted that, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Eldredge discloses "selecting at least a subset of the extracted entries" (i.e., retrieving (selecting) a first or lower level text entities; see col. 3, lines 31-35) "to store based at least in part upon both a spacing between the entries in the index file" (i.e., spacing between entities; col. 9, lines 1-6); and "storing the selected entries" (i.e., stored entries; see col. 10, lines 57-58).

Eldredge fails to explicitly disclose an amount of memory available for allocation. However, Prasad discloses an amount of memory available for allocation (see Prasad col. 8, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Eldredge by an amount of memory available for allocation as disclosed by Prasad (see Prasad col. 8, lines 58-59 and Fig. 5). Such a modification would allow the method of Eldredge to provide a method for temporal indexing for storing and retrieval of multiple audio and video (see Prasad col. 3, lines 62-65), therefore, improving the accuracy and the reliability of the method, apparatus and system for efficient file index.

Eldredge discloses to improve accuracy, the text being indexed and the search queries themselves are often parsed to identify character strings representing words; see col. 1, line 66 to col. 2, line 1. Prasad discloses a method, apparatus and storage medium for management data stream, comprising a plurality of stream segments; see col. 2, lines 15-18. Thus, the combination of Eldredge and Prasad discloses the claimed limitations.

In response to applicant's argument, page 11, paragraphs 1-3, that "the Eldredge and Prasad combination of references ... Applicant notes that Miller is cited as curing, and does not cure, such deficiencies of the Leyda and Prasad combination of references as applied to claims 2, 3, 5, 8, 10, 11, 14 16 and 17. Thus, without the need to further characterize Miller, ..." Applicant respectfully requests the 103(a) rejection of claims 2, 3, 5, 8, 10, 11, 14 16 and 17 be withdrawn. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Eldredge fails to explicitly disclose parsing a play list received through Universal Plug and Play (UPnP) networked communication. However, Miller discloses parsing a play list received through Universal Plug and Play (UPnP) networked communication (see Miller page 104, col. 1, paragraph introduction – 2 and 3). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to

modify the method of Eldredge by parsing a play list received through Universal Plug and Play (UPnP) networked communication as disclosed by Miller (see Miller page 106, col. 1, paragraph introduction – 2 and 3). Such a modification would allow the method of Eldredge to provide a mechanism for universal control (see Miller page 108, col. 2, last paragraph, lines 1-2), thereby improving the accuracy and the reliability of the method, apparatus and system for efficient file index. Further, the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

PEP 2111: During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). For the above reasons, it is believed that the last Office Action was proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 - 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 - 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean Bolte Fleurantin

Patent Examiner

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December 23, 2006



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